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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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CHRISTIE, PARKER & HALE, LLP			LE, THIEN MINH	
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/716,759	Applicant(s) LUCAS ET AL.	
	Examiner Thien M. Le	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

The information disclosure statement filed on 9/23/2004 has been entered.

Claims 1-23 are presented for examination.

Specification

The abstract of the disclosure is objected to because it contains the term "are described". Correction is respectfully required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 10/383,393 (herein after referred to as "the '393 application"). Although the conflicting claims are not identical, they are not patentably distinct from each other because essentially reciting the same limitation.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 1 is rejected in view of claims 1 of the '393 application in that they recite:

1. A data card reader for reading data from a data card possessing an integrated circuit and/or a magnetic stripe, comprising: guiding walls leading to a receiver having an interior surface; a magnetic reading head mounted on one of the guiding walls; and electrical contacts located on the interior surface of the receiver; wherein the receiver is configured to resist the removal of said data card when the data card is located within the receiver.

2. The data card reader of claim 1, wherein: the receiver comprises a base, a rear wall and side walls; and the side walls are configured to provide an entrance to the receiver.

8. The data card reader of claim 2, further comprising a movable latch, where the latch is configured to allow insertion of the data card when the latch occupies a first position and to resist removal of the data card when the latch occupies a second position.

As can be seen, claims 1 and 2 and 8 of the '393 application as combined, would embrace all limitations set forth in claim 1 of this instant application.

Regarding claim 2, see the discussions regarding claim 1. Claim 2 is rejected in view of claim 2 of the '393 application in that it recites:

9. The data card reader of claim 8, wherein the latch is spring loaded.

Similarly,

Claim 7 is rejected in view of claims 1, 2 and 6 of the '393 application in that they recite:

1. A data card reader for reading data from a data card possessing an integrated circuit and/or a magnetic stripe, comprising: guiding walls leading to a receiver having an interior surface; a magnetic

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reading head mounted on one of the guiding walls; and electrical contacts located on the interior surface of the receiver; wherein the receiver is configured to resist the removal of said data card when the data card is located within the receiver.

2. The data card reader of claim 1, wherein: the receiver comprises a base, a rear wall and side walls; and the side walls are configured to provide an entrance to the receiver.

6. The data card reader of claim 2, wherein: the interior surface of the receiver is configured to contact the surface of the data card when the data card is within the receiver; and friction between the interior surface and the data card resists removal of the data card from the receiver entrance.

Claim 8 is rejected in view of claim 3 of the '393 application.

3. The data card reader of claim 2, wherein: the receiver further comprises a top wall; and the base, rear wall, side walls and top wall are configured to prevent all motion of said data card except removal of the data card from the receiver entrance.

Claim 9 is rejected in view of claim 10 of the '393 application.

Claim 10 is rejected in view of claim 1, 2, 6, 8 and 9 of the '393 application.

Claim 11 is rejected in view of claim 7 of the '393 application.

Claims 12-23, see claims 1-22 of the '393 application and the discussions set forth above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1 are rejected under 35 U.S.C. 102(e) as being anticipated by Jones et al. (Jones et al. – USPGPUB 2002/0121886; herein after referred to as Jones).

Regarding claim 1, Jones discloses a card reader having:

- a magnetic head 256 and a magnetic head adjustment screw 257 are illustrated in FIG. 23;
- outer wall 1562 and inner wall 1582;
- a latch 1522 which is pivotally mounted to the frame 1515 by a bolt 1523. The latch 1522 engages a pin 1524 secured to the sorting head. For gaining access to the opposing

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surfaces of the resilient pad 1516 and the sorting head, the latch is pivoted to disengage the pin 1524, and the forward portion of the sorting head is raised to an upward position (not shown) by the torsion springs 1520.

It is noted that though Jones is only directed to a magnetic card reader, not a hybrid type magnetic card/IC card reader as disclosed. However, since claim 1, as broadly considered reciting the term "and/or" in which the electrical contacts are not necessarily "card contacts". And thus would have been embraced by the teaching of Jones.

Claims 1-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Nagata et al (Nagata et al. - 6,659,348, herein after referred to as Nagata).

Regarding claims 1-23, Nagata discloses a data card reader 1 for reading data from a data card 5 possessing an integrated circuit and/or a magnetic stripe, comprising:

- a frame 302 having guiding walls/portion 322 leading to a receiver having an interior surface (fig. 19, col. 11, lines 50+);
- a magnetic reading head 21 mounted on one of the ' guiding walls (figs. 1-4);
- and electrical contacts (i.e., IC contacts springs 11) located on the interior surface of the receiver;

and wherein the receiver is configured to resist the removal of the data card when the data card is located within the receiver (col. 12, lines 4-8);

wherein the receiver is configured to read data from the magnetic stripe during insertion of the data card into the data card reader 1 (col. 4, lines 61+); the receiver comprises a base, a rear wall and side walls; and the side walls are configured to provide an entrance to the receiver; a top wall; and the base, the rear wall, the side walls and the top wall are configured to prevent motion of the data card except removal of the data card from the receiver entrance (figs. 1-4 and 20); a pivotally (i.e., swung) mounted arm/lock lever that is configured to resist removal of the data card from the receiver entrance (col. 4, lines 50+);

wherein the side walls flare outwards at the entrance to the receiver' (figs. 3-4) 4 a front sensor (i.e., which can be the magnetic head 21) and a position sensor 310 (i.e., which is an optical sensor) configured to detect movement of the data card, when the data card is inserted into the receiver (col. 4, lines 3+ and col. 12, lines 15+).

Nagata further discloses that "the rolling element 7 is, for example, a roller, positioned on the card running surface 15 that faces the IC contacts block 12 via the card pathway 14. The roller 7 can be made of rubber, plastic, etc.; the material of the roller is not specifically limited. However, the rolling element 7 is not limited to the roller, but may be a ball. Note that the roller is not a drive roller to which a drive force is transmitted from an actuator such as a motor, but a roller in a free rotational condition that rotates following the movement of the card. In the same manner, the ball is not a drive ball to which a drive force is transmitted from an actuator such as a motor, but a ball in a free rotational condition that rotates following the movement of the card." (also see the descriptions of figures 1-4).

In a preferred embodiment, Nagata discloses that the interior surface of the receiver is configured to contact the surface of the data card when the data card is within the receiver; and friction between the interior surface and the data card resists removal of the data card from the receiver entrance; wherein the interior surface of the receiver contains compressible features (see the description of figs. 1-4).

Further, the examiner considers the spring 207 as a movable latch, where the latch is configured to allow insertion of the data card when the latch occupies a first position and to resist removal of data card when the latch occupies a second position (fig. 7; col. 9, lines 29+).

According to Nagata, the side walls are also configured to form an opening (i.e., recess 4) in the receiver (fig. 3). The interior surface of the receiver is configured to contact the surface of the data card, when the data card is within the receiver; and friction between the interior surface and the data card resists removal of the data card from the opening of the receiver (figs. 1-4; col. 10, lines 1-10). The rollers 7 are mounted in the side walls of the receiver; wherein the rollers are configured to rotate as the data card is inserted into the receiver through the receiver entrance.

As can be seen, Nagata discloses the claimed invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (571) 272-

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2396. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Le, Thien Minh
Primary Examiner
Art Unit 2876
October 3, 2005